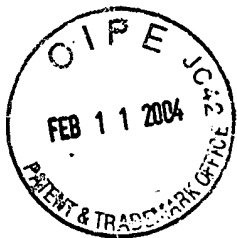


I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 9, 2004.

Scott W. Kelley, Reg. No. 30,762

February 9, 2004

Date



IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of

Helen Hardman Howlett-Campanella

Serial No. 09/765,533

Filed: January 19, 2001

For: YOGA MAT WITH BODY CONTACT
PLACEMENT INDICIA

Group Art Unit: 3764

Examiner: Lori Baker Amerson

Docket No. HOWL-38283

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

FEB 17 2004

TECHNOLOGY CENTER R3700

Dear Sir:

APPELLANT'S REPLY BRIEF (37 C.F.R. § 2.142(b)(1))

This Appellant's Reply Brief is submitted in triplicate, pursuant to the provisions of 37 C.F.R. § 2,142(b)(1), and in response to the Examiner's Answer mailed January 13, 2004.

AF
3764

#18/55
2-18-04

acknowledged
by Examiner
on
4-16-04

REPLY TO EXAMINER'S ANSWER - REJECTIONS UNDER 35 U.S.C. §112

The Examiner rejected claim 23 under 35 U.S.C. §112, first paragraph, on the basis that the plurality of markers 54, 56 and 58 were allegedly not described in the specification nor the subject matter pertaining to the plurality of rectangles separated into six non-overlapping sets in line 12-13.

As pointed out in the Appeal Brief, a review of the figures of the provisional and non-provisional applications clearly show the circular indicia identified by markers 54, 56, and 58 as well as the plurality of rectangles separated into six non-overlapping sets (e.g., FIG. 8 shows rectangles (unnumbered) with 90 degree corners and sides formed by the intersections of broken lines 30, 32, 48 et al with each other and with the edge of the mat).

Appellant has always taken the position that the circular indicia identified as markers 54, 56 and 58 have always been shown in the figures of the instant application and in the figures of the provisional applications from which the instant application claims priority. The Examiner's Answer states that the Examiner has consistently disagreed with this statement and the Appellant maintains that the Examiner has been consistently wrong on this issue.

Examiner Failed to Rebut Arguments and Evidence Submitted:

As outlined in more detail below, the Examiner's Answer fails to rebut several issues raised by the Appellant in the Appellant's Brief. The Examiner admits that the circular indicia or 'markers' are shown in the figures of the instant application as originally filed and in the provisional applications but still maintains that the circular indicia are new matter. The Examiner failed to consider the declarations of the Appellant and the Draftsperson

who created the figures of the Appellant's non-provisional application which support the circular indicia as always having been part of the figures.

The Examiner also failed to address the fact that MPEP Section 2163.06 states that "information contained in any one of the specifications, claims or drawings of the application, as filed, may be added to any part of the application without adding new matter"; that the drawings alone are a sufficient basis for adding the description of the circular indicia as 'markers' in the description.

The Examiner further failed to provide any definition of 'mark', or 'marker' or specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia shown in the figures is repugnant to the usual meaning of the term.

The Examiner additionally failed to provide any support for the Examiner's contention that the term 'marker' is an additional element separate from indicia forming the body placement guide. The Examiner implied that it was improper for Appellant to take the term 'marker' from Marquez U.S. 5,564,494 which described the same and/or similar circular indicia as a 'marker' yet the Examiner failed to provide any legal basis why it would be improper for Appellant to do so if the Appellant is deliberately trying to provoke an interference with Marquez.

Examiner Advances Unsupported Theory Contradicted by Declarations Submitted by Appellant and Draftsperson:

The Examiner has stated on the record that the circular indicia or 'markers' are shown in the figures of the instant application as originally filed and in the provisional applications. However, while the Examiner acknowledges the existence of the circular

indicia in the figures, the Examiner advances a theory, bereft of any evidentiary support, that the circular indicia are some sort of drafting error and are merely darkened points on the drawings that have occurred as a result of an intersection of multiple lines. This is mere conjecture and speculation on the part of the Examiner. The Examiner failed to acknowledge the declarations of the Appellant and the Draftsperson who created the figures of the Appellant's non-provisional application (previously submitted with the Appeal Brief as Exhibits "F" and "G") which directly contradict the Examiner's position. There is no indication, one way or another, if the Examiner has ever reviewed the declarations previously submitted. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The declarations are evidence that the circular indicia shown in the figures were not an accidental by-product of several lines intersecting. The Appellant had communicated the substance of this to the Examiner during the first telephonic interview. The declarations had not been submitted earlier because, as discussed in the Appeal Brief in the Record of Interviews, Appellant's Attorney had been waiting to hear back from the Examiner's Supervisory Primary Examiner (SPE) as the SPE had told Appellant's Attorney that he would discuss the new matter issue with the Examiner and get back to Appellant's Attorney. The Examiner's SPE never contacted Appellant's Attorney prior to the last communication from the Examiner stating that the Examiner and her SPE were standing by the rejection. The overwhelming impression given to Appellant by the Examiner and her SPE on the new matter issue was that further prosecution would be futile as there was

little doubt that their minds had been made up and an Appeal would be the most expedient way of resolving the new matter issue. The need to file the Appeal was further buttressed by the Examiner's on-the-record waffling of whether or not Dionne disclosed subject matter relating to indicia positioned and/or extending from at least one of the axis at a 45 degree angle.

Without waiver of the above, it is clear that the intersections of the lines themselves, and not just the circular indicia, can be described as a 'marker'. For example, as seen in FIG. 8 of Appellant's application (see Exhibit "G" of Appeal Brief), there are fifteen different locations where various lines identified by reference numbers 30, 32, et al. intersect to form a marker. Circular indicia, identified by reference numbers 56, 58 are located at the center of a number of those intersections of lines (i.e, 'markers').

The declaration of the Appellant attests to the fact that the circular indicia have always been a part of the figures of the provisional and non-provisional applications. The declaration of the Draftsperson attests to her having prepared the figures filed in the non-provisional application and that the appearance of circular indicia at certain intersections of lines in the figures is not an accidental drawing by-products of the several lines intersecting at the various locations. The Draftsperson specifically pointed out an error made by Applicant's Attorney in amending Figure 8, and the proposed correction was included in the Brief.

Information From the Drawings Added to the Description Does Not Add New Matter:

The Examiner failed to address the fact that MPEP Section 2163.06 states that "information contained in any one of the specifications, claims or drawings of the

application, as filed, may be added to any part of the application without adding new matter." Instead, the Examiner stated in the Answer that there is no evidence in the specification or labeling in the drawings of the provisional(s) applications or the instant application to reference such elements as 'markers.' The Examiner is improperly attempting to require an applicant to include evidence and arguments in the specification regarding features shown only in the drawings. This essentially requires a patent applicant, at the time their patent application is filed, to divine objections/rejections the PTO will proffer when the applicant later tries to describe in the written specification any feature that is shown only in the drawings as filed. Fortunately, MPEP 2163.06 makes no such requirement. Under MPEP 2163.06, all that is required is that the circular indicia were shown in the figures of the application as originally filed. Additionally, as mentioned above, each of the fifteen different locations in FIG. 8 where various lines identified by reference numbers 30, 32 et al intersect can be described as a 'marker'. Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed. See *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.* 291 F.3d 1357; 62 U.S.P.Q.2D 1846 (2002).

The Examiner admits that the circular indicia, as well as the intersections of lines, are shown in the figures. However, the Examiner takes the unsupported position that describing these circular indicia in the written description somehow constitutes new matter. The only proof offered by the Examiner that the circular indicia are new matter is an unsupported theory that the circular indicia are a drawing by-product. This theory is directly contradicted by the declaration of the Draftsperson who has stated on the record that the circular indicia were part of the drawings as originally filed.

Use of The Term 'Marker' Consistent With The Term's Ordinary Meaning:

Pursuant to MPEP 2111.01, an applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). In the Examiner's Answer, the Examiner states that the Examiner has consistently remarked that based upon the general definition of a mark, or marker, that there is no evidence in the disclosure to support the indicia Appellant claims as a 'marker'. The Examiner has never provided Appellant with any definition of 'marker' to support her contention. In fact, the Examiner has failed to even acknowledge the definitions of 'marker' and 'mark' provided by the Appellant in the Appeal Brief and has further failed to specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia is repugnant either to the usual meaning of the term or the definitions provided by Appellant. When the Examiner states that there is no evidence in the disclosure to support the indicia Appellant claims as a 'marker', it is quite clear that the Examiner has obviously never heard of the age-old expression "X marks the spot". In this case, the circular indicia (as well as the fifteen individual intersections of lines shown in FIG. 8) clearly mark the spot(s) and can therefore be accurately described as 'markers'.

As outlined in the Appeal Brief, usage of the term 'marker' to describe the circular indicia is not repugnant to either the term's well known usage or the definitions provided by Appellant, and is also completely consistent with the use of the same term in the Marquez patent, as stated below.

Use of The Term 'Marker' is Consistent With Use in Marquez:

The Examiner further claims that Appellant has attempted to include the limitations of the markers only after discovery of prior art not cited (i.e., Marquez U.S. 5,564,494) in response to a final office action. The Examiner assertion to the contrary, under the MPEP, Marquez is NOT considered prior art. Marquez claims the benefit of a March 3, 2000 filing date and did not issue until May 14, 2002. The instant application claims the benefit of a provisional application filing date that predates the Marquez filing date. Marquez is therefore not prior art. In point of fact, Marquez issued one month prior to the mailing of the June 14, 2002 final office action mentioned by the Examiner and it was Appellant who brought Marquez to the Examiner's attention in the Response to that very same final office action. The Appellant brought Marquez to the Examiner's attention; not the other way around.

Use of the term 'marker' in the instant application is consistent with Marquez as Marquez uses that very same term to describe circular indicia on the surface of the Marquez mat. Appellant is merely using a term already used in Marquez (i.e., to describe the circular indicia of the Marquez mat) to describe the same and/or similar feature in the instant application. The term 'marker' is therefore not being used in any manner as to give it a special meaning or a meaning repugnant to the usual meaning of the term. See MPEP 608.01(o) [Basis for Claim Terminology in Description].

Based upon the foregoing definitions, the manner in which the term 'marker' is used in the specification, and the source of the term (i.e., Marquez), it is clear that the term properly describes the circular indicia shown in the figures, especially in view of the intent to keep the language of claim 23 consistent with Marquez. The term 'marker' is completely

consistent with the specification to describe the body placement guide as providing various marks/markers for a yoga practitioner to use to align their body during yoga exercises.

Marker Is Not An Additional Element:

The Examiner claims that the term 'marker' is an additional element. However, the Examiner fails to provide any explanation or legal support for this position. The Appellant has clearly stated on the record that the circular indicia, identified as markers 54, 56, 58, are part of the indicia forming the body placement guide. However, the Examiner maintains that a 'marker' must be some sort of physical structure other than the circular indicia. The Examiner has failed to provide any legal citation or evidence to support this position. As mentioned above, one age-old expression is "X marks the spot". Indicia, in the form of an "X" drawn on a surface, clearly acts as a marker without there being any three-dimensional physical structure.

Based on the foregoing, it is respectfully requested that the new matter objection to the specification and new matter rejection of claim 23 be overturned.

DIONNE ET AL U.S. PATENT NO. 5,645,494 IS NON-ANALOGOUS ART

Under In re Wood, 202 USPQ 171, 599 F. 2d 1032, the determination that a reference is from a non-analogous art is twofold. First, the Examiner must determine if the reference is within the field of the inventor's endeavor. If it is not, then the Examiner proceeds to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

The Examiner merely states in a conclusory manner that the instant application and the Dionne reference both claim a mat using indicia to define a particular use, and that the structural limitations, as broadly claimed, of the claimed invention are reasonably met by Dionne. The Examiner fails to provide any reasoning that led the Examiner to this conclusion. The Examiner has failed to make a proper determination if the Dionne reference is within the field of Appellant's endeavor and has also failed to determine whether the Dionne reference is reasonably pertinent to the particular problem with which the Appellant was involved.

As admitted by the Examiner, Dionne fails to disclose a yoga mat. Dionne is a non-analogous reference in that Dionne's field of endeavor is golf while the field of endeavor of the instant application is yoga. A yoga mat is not related to a golf mat any more than the golf mat of Dionne is related to a bath mat or a door mat. Golf mats and yoga mats are simply not in the same field of endeavor; golf and yoga are two very distinct activities. Golf mats and yoga mats each have their own unique features directed to solving very different problems. There is no suggestion or motivation disclosed in Dionne to suggest that one of ordinary skill in the art would think that a golf mat reference would be reasonably pertinent to the particular problem relating to yoga mats with which the Applicant was concerned.

As outlined in detail below and in the Declaration of the Appellant (see Exhibit "F" of Appeal Brief), the claimed subject matter involves a yoga mat and, in the body of several of the independent claims, it is clearly and unequivocally stated that the symmetrical body placement guide on the upper surface of the mat is configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. The Examiner explicitly

admitted in the Office Action of May 14, 2003 that Dionne does not disclose a mat configured to aid a yoga practitioner's body during yoga postures.

One of ordinary skill in the art would not be looking to a golf mat to solve problems in the yoga area. A review of the figures of Dionne amply illustrate that the structure and surface of the Dionne golf mat are simply not suitable for the practice of yoga. The surface of the Dionne golf mat is covered with a harsh Astroturf (col. 3, lines 42-46) and, as shown in Figures 2a and 2b, the golf mat is not conducive to the type of full-body exercises associated with yoga that involve stretching, sitting, kneeling, standing, laying on one's back, stomach, side, etc. In contrast, the golf mat of Dionne is directed only for standing and swinging of a golf club (col. 4, lines 4-22). One of ordinary skill would be well aware that yoga involves all parts of the body coming into contact with the yoga mat and not just the user's feet, as in the Dionne golf mat. One of ordinary skill would also be well aware that yoga involves many different positions (e.g., prone, kneeling, sitting etc.) and not just a standing position, as in the Dionne golf mat. A standing position is only one part of yoga and even then, the golf mat of Dionne would not be appropriate for yoga exercises that involve standing as the size and shape of the Dionne mat is quite different than the elongated shape of a yoga mat.

For the foregoing reasons, Dionne et al. is non-analogous art.

RESPONSE TO EXAMINER'S ANSWER - REJECTIONS UNDER 35 U.S.C. §103

The Office Action rejected claims 1 and 3-23 in a single reference rejection for obviousness under 35 U.S.C. 103. Appellant hereby reiterates its arguments against all the rejections, as stated in the Appeal Brief and incorporates them herein. The Examiner's Answer fails to address several of the issues raised by the Appellant in the Appeal Brief. For example, the Examiner repeatedly fails to provide any suggestion or motivation to modify Dionne et al. other than a repeated assertion that any difference between what is disclosed in Dionne and what is claimed by the Appellant is merely a 'design consideration' or other such variation of 'design choice'.

Claims 1, 3-22:

Appellant hereby reiterates its arguments against the rejections of claims 1 and 3-22 as stated in the Appeal Brief and incorporates those arguments herein. The Appellant hereby addresses the arguments in favor of obviousness raised by the Examiner in the Examiner's Answer.

i. Elongated mat

Dionne fails to disclose an elongated mat. The mat shown in Figure 1 of Dionne can hardly be described as elongated. The *American Heritage® Dictionary of the English Language: Fourth Edition (2000)* defines 'elongated' as.

1. Made longer; extended.
2. Having more length than width; slender.

The generally rectangular mat shown in Figure 8 of Dionne can by no means be considered "slender." In response to the Appellant's position that the Dionne mat is not elongated, the Examiner essentially admits that Dionne does not disclose an elongated

mat. Instead, the Examiner claims that a change in shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). The Examiner makes the unsupported statement that it would have been obvious to one having ordinary skill in the art at the time the invention was made to design the mat of Dionne in an elongated shape in order to provide more area on the surface of the mat for the user to stand. However, the Examiner fails to provide any support that one of ordinary skill would have had any suggestion or motivation to do so. Dionne does not raise the issue that a user of the instruction golf mat needs any more room to stand. In fact, the Dionne reference is directed to teaching a user where to position their feet on a golf mat and, in fact, is teaching that a user only needs the amount of standing room provided by the Dionne golf mat. Additionally, changing the shape of the Dionne mat to an elongated shape would substantially interfere with the placement of various surface feature of the Dionne golf mat, such as the 'sand trap', tee locations, and 'rough' areas. For example, if the Dionne golf mat was the same elongated, slender shape of a yoga mat, the sand trap, tee locations and 'rough areas' would have to be aligned in a linear manner, adjacent to each other, along the length of the golf mat. This would require the user to have to step in the sand trap in order to use the tee or stand in the simulated 'rough' in order to use the sand trap, etc. This would seriously impact the foot placement function of the golf mat and render the golf mat of Dionne unsuitable for its intended purpose. The use of an elongated golf mat at a driving range would also take up much more space and require the driving range to reduce the number of slots available for golfers to practice their swings.

The shape of a yoga mat is not a simple matter of design choice. The yoga mat is elongated to match the general shape of a human body (i.e., elongated). The elongated

shape of the yoga mat is conducive to yoga positions that require a user to be in a prone position. The slender shape of the yoga mat informs the user when their arms and/or legs have strayed well out of position as the user will be aware when their arms and/or legs have left the confines of the yoga mat. The Dionne golf mat is not elongated, was never intended to be used with a user laying on the golf mat in a prone position, would be rendered unsuitable for its intended use if the golf mat were elongated, and is simply not suitable for yoga exercise.

ii. Symmetrical Body Placement Guide:

Dionne further fails to describe a symmetrical body placement guide on the upper surface of the mat and configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. The Examiner's Answer states that Dionne discloses a symmetrical body placement guide (30) on the upper surface of the mat. However, reference number 30 of Dionne merely describes a grid pattern (col. 3, line 64) and fails to give the claim its broadest reasonable interpretation consistent with the specification. See MPEP 2111 [Claim Interpretation; Broadest Reasonable Interpretation]; *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

The Examiner contends that the pattern of Dionne is a guide for foot placement (col. 4, lines 5-6), which are part of the body. However, the language of the claim clearly states that the symmetrical body placement guide was configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. All the words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970) (Every limitation positively recited in a claim must be given effect in order to

determine what subject matter that claim defines.). The claims clearly state that the claimed invention is a yoga mat which includes a symmetrical body placement guide on the upper surface of the mat and configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. The Examiner's Answer attempts to dismiss the recitation of these features by stating that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). However, with regard to the Examiner's use of a *per se* rule such as that derived from Ex parte Masham, it is respectfully submitted that the Examiner's attention be directed to In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) wherein the Federal Circuit has held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

As stated in In re Wilder, every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. The Examiner fails to take into account that, while the golf mat of Dionne is useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body, not just the feet. A fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all

parts of the human body which can be in contact with the mat while only the feet of a user are in contact with a golf mat. A large portion of a yoga practitioner's body can be in contact with the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures.

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (The Board's construction of the claim limitation "restore hair growth" as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The Federal Circuit held that, consistent with applicant's disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe "restore hair growth" to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair.). In this manner, the Examiner is improperly limiting the body placement guide to only refer to the user's feet while the Appellant's disclosure clearly shows that yoga involves more than just the yoga practitioner's feet being in contact with the body placement guide. While golf involves standing and swinging, at no time would one of ordinary skill in the art think that golf involves sitting, kneeling, or laying in a prone position on a golf mat. The Examiner fails to give the phrase 'body placement guide' its broadest reasonable interpretation by limiting the guide as only involving a yoga practitioner's feet.

iii. Indicia Extending From Longitudinal Axis at Forty-five Degree Angle:

The Examiner's Answer admits that Dionne does not disclose indicia (i.e., lines) extending from either the longitudinal axis or the transverse axis at a 45 degree angle. However, the Examiner attempts to skirt the issue by stating that absent a teaching as to criticality that the indicia extend from the longitudinal axis at a 45 degree angle, this particular arrangement is deemed by the Examiner to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). The Examiner completely ignores the fact that the body placement guide disclosed in the specification and claims serves the stated purpose of being configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures.

The Examiner is improperly trying to require that the Appellant should have included evidence and arguments in the specification regarding the 45 degree angle feature. In In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995), the Federal Circuit held that the Patent and Trademark Office erred in ruling that an applicant's arguments and evidence concerning the advantages of the claimed invention's modification of the prior art should not be considered when the applicant's specification was "virtually silent" about the modification's advantages and failed to state that the modification solved any particular problem or achieved an unexpected result.

The Examiner is implying that the 45 degree angle feature is a mere 'design choice' absent a teaching as to criticality that the indicia extend from the longitudinal axis at a 45 degree angle since the instant specification and evidence of record fail to attribute any

significance (novel or unexpected results) to the particular arrangement. In Chu, the Federal Circuit stated that the Examiner's rationale was wrong. The Federal Circuit stated that '[t]o require [an applicant] to include evidence and arguments in the specification regarding whether [the modification of the prior art] was a matter of 'design choice' would be to require patent applicants to divine the rejections the PTO will proffer when patent applications are filed."

As in Chu, the Examiner improperly relies on In re Kuhle to support the rejection. The Chu court held that "the cases ... relied on do not support [the] position that evidence and arguments must be found in the specification to be considered in an obviousness determination. In each case [cited], the applicant failed to set forth any reasons why the differences between the claimed invention and the prior art would result in a different function or give unexpected results. The cited cases were In re Rice, 341 F.2d 309, 144 USPQ 476 (CCPA 1965) ('Appellants have failed to show that the change [in the claimed invention] as compared to [the reference], result in a difference in function or give unexpected results.') and In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) ('Use of such means of electrical connection in lieu of those used in the references solves no stated problem and would be an obvious matter of design choice within the skill in the art.' (emphasis added) (citations omitted)).

The Appellant has repeatedly included evidence and arguments with respect to the value of the body placement guide and the features thereof. The Appellant has stated on the record that a fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user contact a golf mat.

The Appellant has further stated that a large portion of a yoga practitioner's body can be in contact with the yoga mat in prone, supine or sitting positions. The Appellant has additionally stated that even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. The Appellant has consistently maintained that the indicia, in the form of the body placement guide, help a yoga practitioner align their body.

As admitted by the Examiner, Dionne does not disclose any lines extending from an axis at a 45 degree angle. There is nothing in Dionne that explicitly or impliedly suggests the limitations of indicia positioned from the longitudinal axis at a forty five degree angle. The Examiner's rationale for finding this feature in Dionne is a purely hindsight reconstruction that improperly relies on the Applicant's specification to modify Dionne. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

iv. Multiple Segments and Step Indicia:

The Examiner's Answer fails to present anything more than a conclusory statement that multiple segments of equal area parallel to the transverse and longitudinal axis are disclosed in col. 4, lines 14-67) and include indicia for step (36; col. 4, lines 58-59). The Examiner also fails to provide any explanation that indicates the Examiner is using the broadest reasonable interpretation of the terms 'multiple segments' and step 'indicia' that are consistent with the specification. The Examiner additionally fails to describe which

individual feature forms an individual segment so that Applicant is able to determine what is being interpreted as a 'multiple segment'. The Examiner further fails to provide any motivation or suggestion for modifying Dionne in this manner.

For the foregoing reasons, the rejection to claims 1, 3-22 should be overturned.

Claim 23:

37 CFR § 1.193 (a)(2) provides that an Examiner's Answer must not include a new ground of rejection. The Examiner has presented a modified rejection of Claim 23 that differs from the rejection set forth in the Office Action dated May 14, 2003 in that the Examiner now, for the first time, admits that Dionne does not disclose a plurality of rectangles and that Dionne does not disclose markers located in the center of each quadrant. With respect to other admissions of features not shown in the Dionne reference, the Examiner also admits that Dionne does not disclose six non-overlapping sets of quadrants.

The Examiner's piecemeal rejection attempts to distort the elements claimed in claim 23 by only selectively addressing certain elements of the claim. This is nothing more than an attempt by the Examiner at doing an end-run around having to explain how each and every element of claim 23 is rendered obvious by Dionne. Claim 23 claims a yoga mat, comprising:

- a mat comprised of a flat structure having an upper surface, a lower surface and a longitudinal axis;
- a first center line positioned upon said upper surface of said mat;
- a second center line positioned upon said upper surface of said mat parallel to said longitudinal axis and orthogonal with respect to said first center line, wherein said second center line intersects said first center line;
- a plurality of first lines parallel to said first center line;
- a plurality of second lines parallel to said second center line;

wherein said first center line, said second center line, said plurality of first lines and said plurality of second lines provide a plurality of rectangles upon said mat, wherein said plurality of rectangles are separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of said second center line wherein each set of said four quadrants has a center point; and
a plurality of markers wherein a single marker is located on selected intersections of said plurality of second lines with said first line and at each said center point of each set of four quadrants.

The Examiner's rejection attempts to improperly simplify the claim to comport with what is disclosed in Dionne and then dispose of the remaining features under the rubric of 'design consideration'. For example, the Examiner states that the Applicant should note that, with respect to the rectangular shape, a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). However, this 'change of shape' has nothing to do with the fact that the plurality of rectangles are separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of the second center line and that each set of four quadrants has a center point. The Examiner simply cannot equate a claim limitation specifying that the plurality of rectangles separated into six non-overlapping sets of four quadrants with a change in shape (e.g., square to circular). As admitted by the Examiner, this is a feature not disclosed by Dionne. The Examiner attempts to skirt this fact by stating that Dionne discloses four quadrants each having a center point. However, this is not the language of claim 23 which calls for a plurality of rectangles separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of the second center line and that each set of four quadrants has a center point.

A marked up version of FIG. 8 (with the lines forming the sides of the rectangles completed in phantom) has been provided for the purpose of providing clarity and is attached hereto in the Appendix as Exhibit "A". As seen in the marked-up figure, a first center line 32 is positioned on the upper surface of the mat. A second center line 30 is positioned on the upper surface of the mat orthogonal with respect to the first center line 32. The second center line 30 intersects the first center line 32. A plurality of first lines are shown parallel to the first center line 32. A plurality of second lines are shown parallel to the second center line 30.

The first center line 32, the second center line 30, and the plurality of first lines and the plurality of second lines provide a plurality of rectangles on the mat which are separated into six (A, B, C, D, E, F) non-overlapping sets of four quadrants (I, II, III, IV) which define a unit area on opposing sides of the second center line. The 90 degree corners and sides of the rectangles/quadrants are formed by the intersections of broken lines 30, 32, 48 et al with each other and with the edge of the mat.

Each set of the four quadrants (I, II, III, IV) has a center point. The figure also shows a plurality of markers and that a single marker is located on selected intersections of the plurality of second lines with the plurality of first lines and at each center point of each set of four quadrants.

The Examiner attempts to reject the claim on the basis that Dionne discloses a mat divided into four quadrants with a single center point where one corner of each of the quadrants meet. However, as outlined above, the Appellant's mat is separated into six non-overlapping sets of four quadrants defining a unit area on opposing sides of the second center line where each set of four quadrants has a center point; a feature the

Examiner has admitted is not shown in Dionne. The Examiner has failed to provide any explanation as to why the Dionne reference could and/or should be modified to meet this limitation.

i. Flat Structure

Once again, the Examiner has failed to disclose how Dionne allegedly discloses a flat structure suitable for use as a yoga mat. The Dionne golf mat, as seen in Figures 2a and 2b, can hardly be described as 'flat'. Dionne specifically discloses that vertical fibers 23 of top surface 24 may vary in length 27 between different portions of the top surface 24 to simulate fairway or rough conditions all on the same mat and that a portion of the golf mat is designed to simulate a sand trap 29 (col. 3, lines 48-63). The uneven surface of Dionne is not suitable for use as a yoga mat.

ii. Center Points of Rectangles

The Examiner states in a conclusory manner that the rectangles are separated into four quadrants each having a center point (at an intersection of lines). However, the Examiner fails to provide any suggestion or motivation in Dionne for a center point. Dionne fails to disclose a center point in each of the four quadrants that may be created by the intersection of lines 40 and 42 of Dionne.

iii. Markers

The Examiner admits that Dionne does not disclose markers located in the center of each quadrant. More particularly, the Examiner is admitting that Dionne fails discloses a plurality of markers wherein a single marker is located on selected intersections of the plurality of second lines with the first line and at each center point of each set of four quadrants.

Instead, the Examiner's Answer states in a conclusory manner that Dionne discloses a plurality of markers (25) located on selected intersections of the second lines with the first line and at each center point of each of the quadrants (page 6, lines 16-17, Examiner's Answer). However, a few sentences later, the Examiner admits that Dionne does not disclose markers located in the center of each quadrant (page 6, line 20, Examiner's Answer). The Examiner simply can not claim that Dionne discloses the feature while concurrently admitting that Dionne does not disclose that feature.

The Examiner then goes on to state that, with respect to the markers in the center, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the tee locations of the Dionne golf mat in the center of the quadrants, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70 (page 7, lines 1-5, Examiner's Answer). In Japikse, the claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device. However, it has been held by this Board that "[t]he mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). The Examiner has failed to set forth any motivation or reason why a worker in the art, without the benefit of Appellant's specification, would have made the necessary changes in the Dionne mat.

Even more importantly, the Examiner ignores the fact that the proposed modification of moving the so-called 'markers' (i.e., tee locations 25 of Dionne) to the center point of each quadrant would render the golf mat of Dionne unsatisfactory for its intended purpose, which is to provide a surface that simulates that of a golf course fairway with various heights of 'grass' (i.e., Astroturf), sand hazards, etc. Not only that, tees are located near or at the edges of a golf mat for a specific reason because the typical golfer only uses tees in conjunction with the use of their drivers (e.g., a #1, #2 or #3 wood). The drivers are relatively long and cut a large swath as the golfer swings the driver towards the ball resting upon the tee. Moving the tees towards the center of the mat would force the golfer off the mat and would destroy the efficacy of the Dionne mat as an instructional aid for foot placement, etc. It has been held that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Additionally, the tee locations 25 of Dionne are actually holes in the mat for the tees to be located in and extend upwardly from. The Examiner is attempting to mix apples and oranges by substituting the holes (i.e., tee locations 25) of Dionne for the markers 54, 56, 58 of the instant application.

As outlined above, claim 23 was copied from claim 9 of the Marquez patent. It is ironic that Dionne was the only reference cited against Marquez yet claim 9 of Marquez was found to be allowable over Dionne. While different Examiners may have different interpretations of what a reference like Dionne discloses, it is simply inequitable for one

Examiner to allow a claim over a particular reference in one application while a second Examiner rejects the identical claim in another application using the same reference.

For the foregoing reasons, the rejection to claim 23 should be overturned.

Respectfully submitted,

KELLY BAUERSFELD LOWRY & KELLEY, LLP

By: 

Scott W. Kelley
Reg. No. 30,762
Attorney for Applicant

SWK/MJS

Enclosure: Exhibit A (submitted in triplicate)

6320 Canoga Avenue
Suite 1650
Woodland Hills, CA 91367
(818) 347-7900

FORMAL DRAWINGS

Inventor: Helen Hardman Howlett-Campanella

Entitled: YOGA MAT WITH BODY

Serial No.: 09/765,533

Filed: January 19, 2001

Docket No.: HOWL-38283

Sheets of Drawings: One (submitted in triplicate)

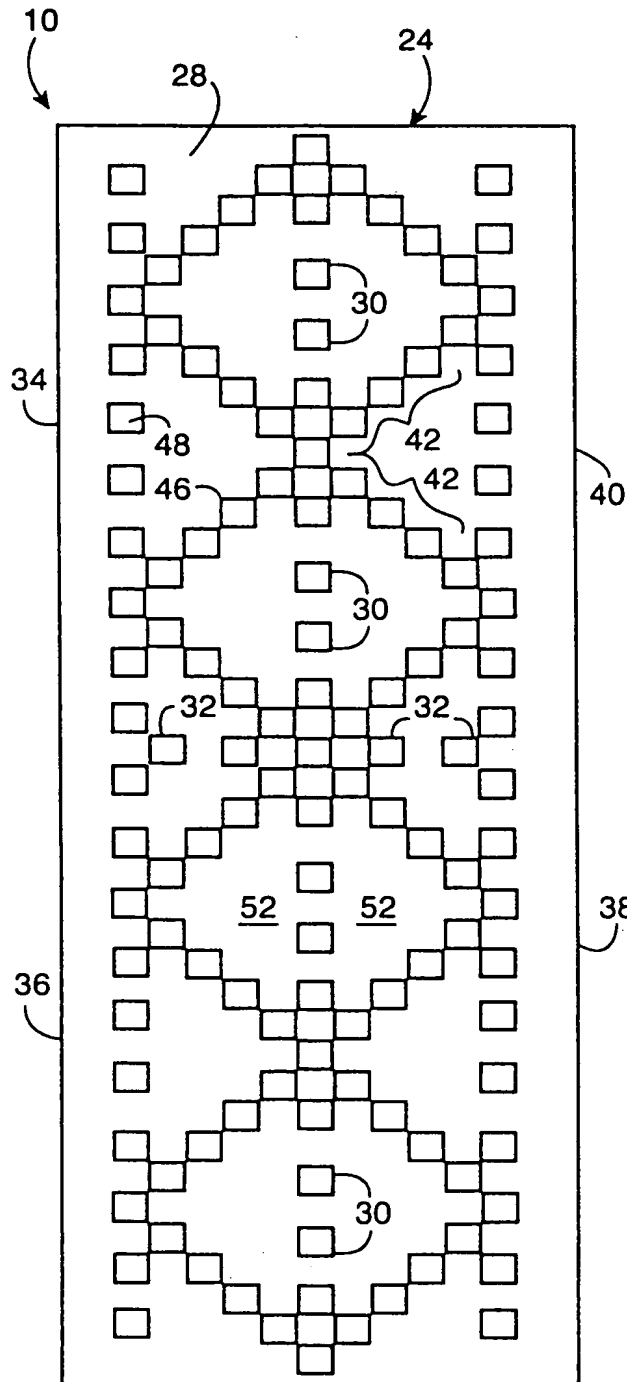


FIG. 7

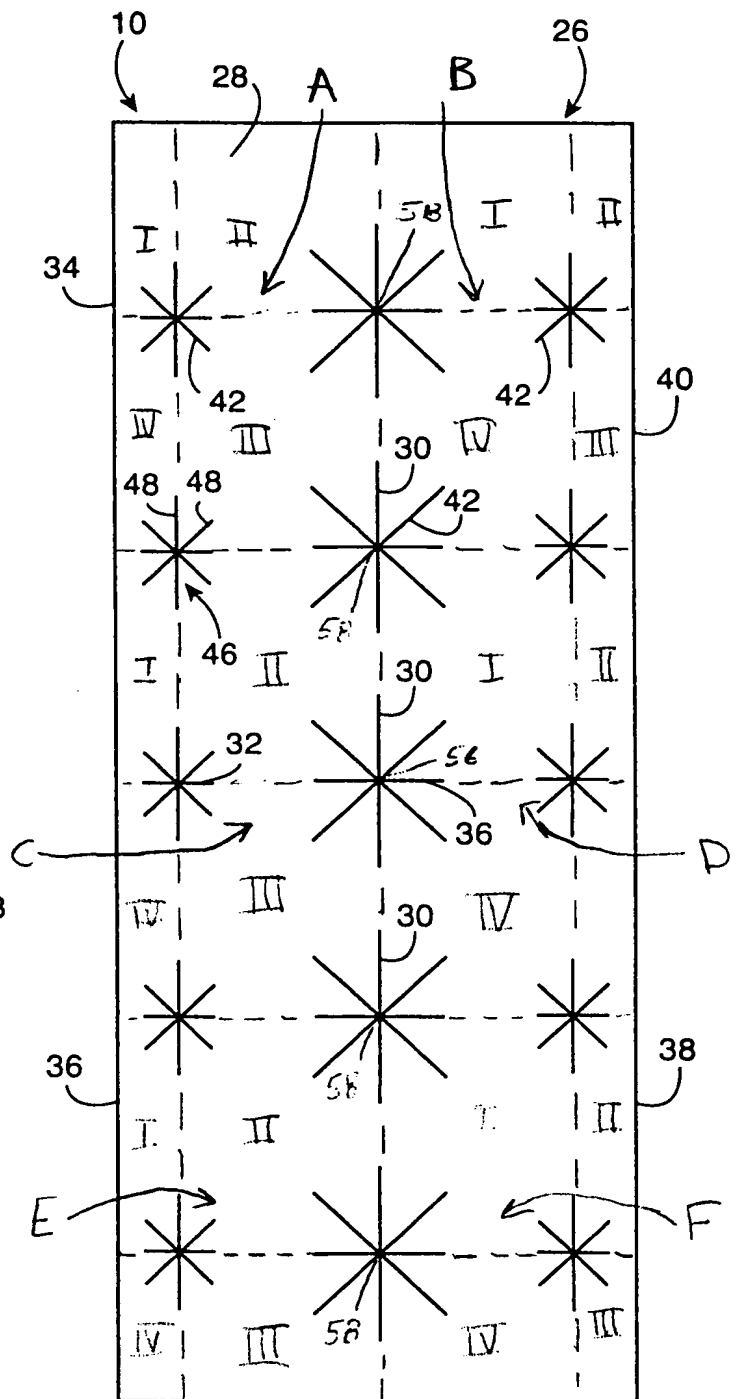


FIG. 8

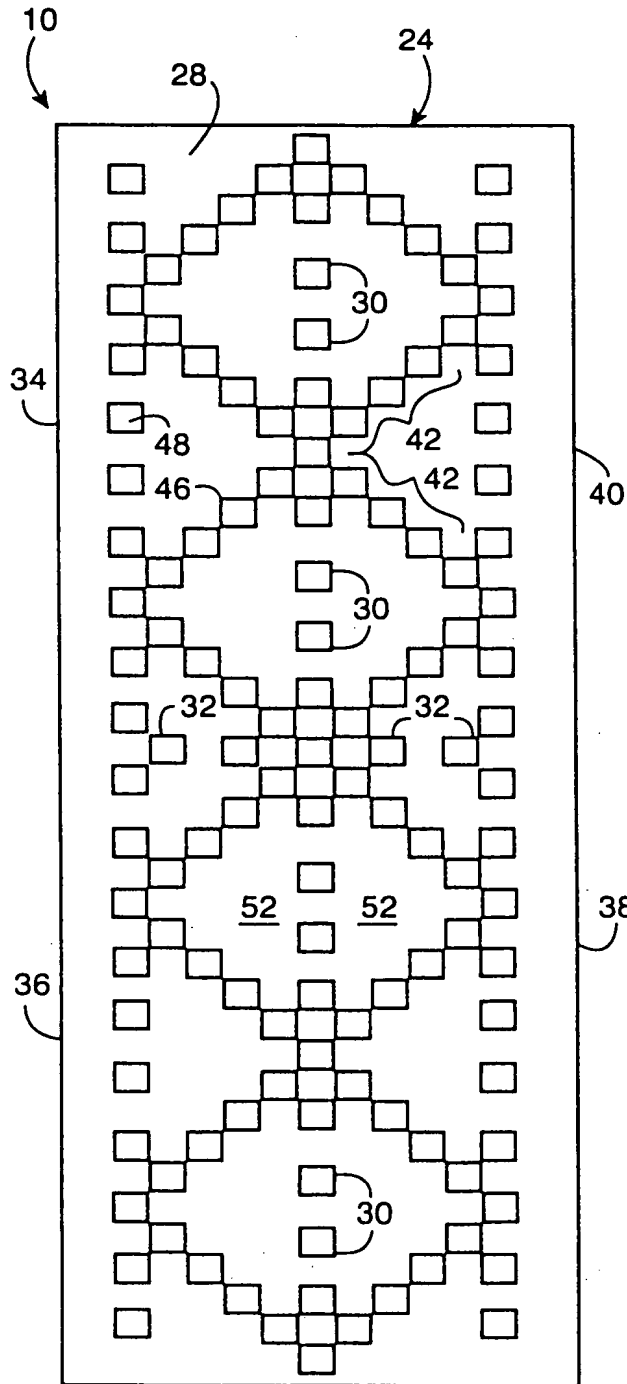


FIG. 7

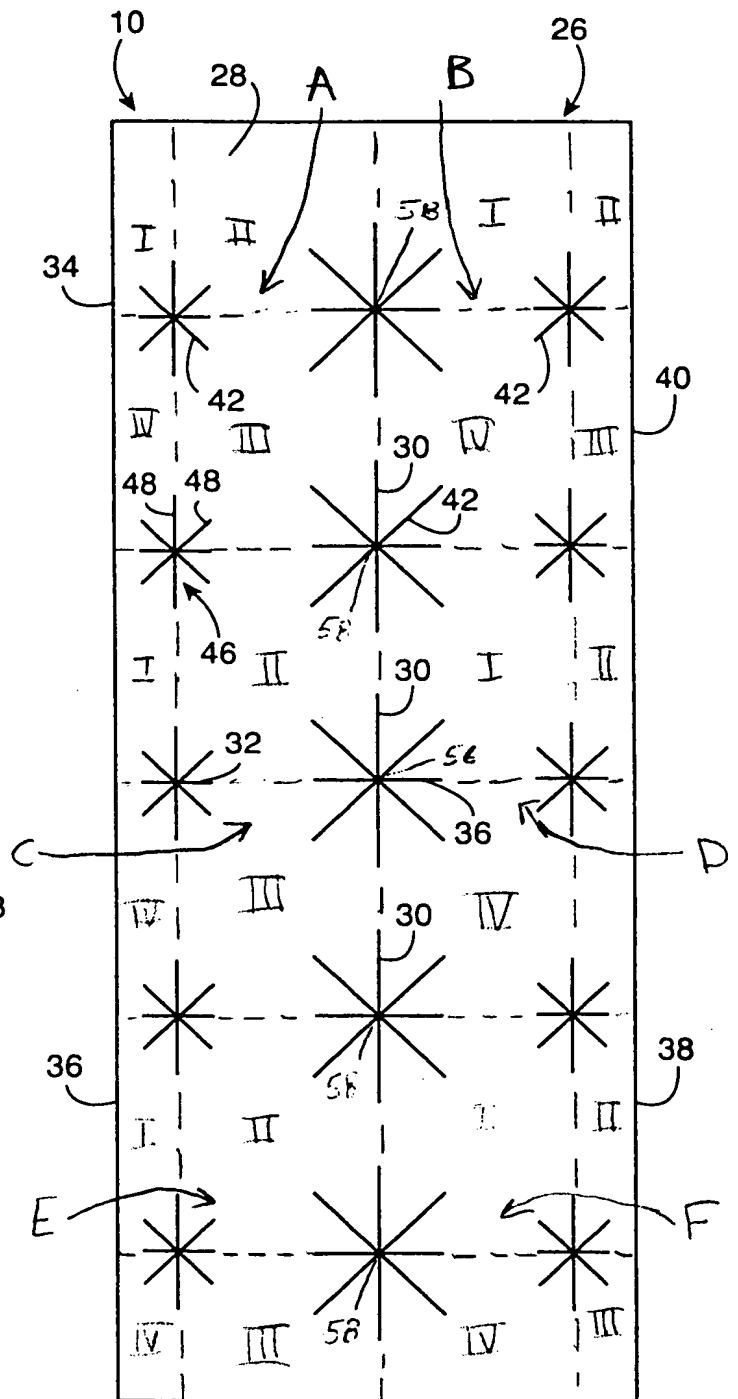


FIG. 8

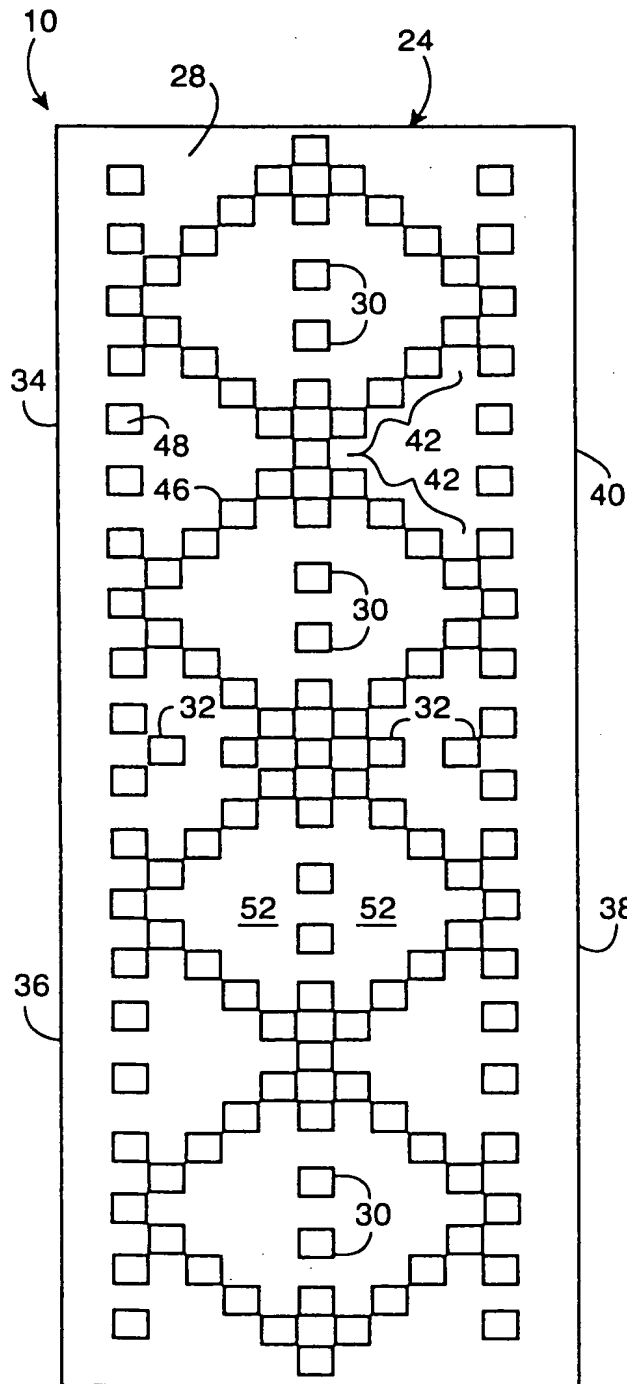


FIG. 7

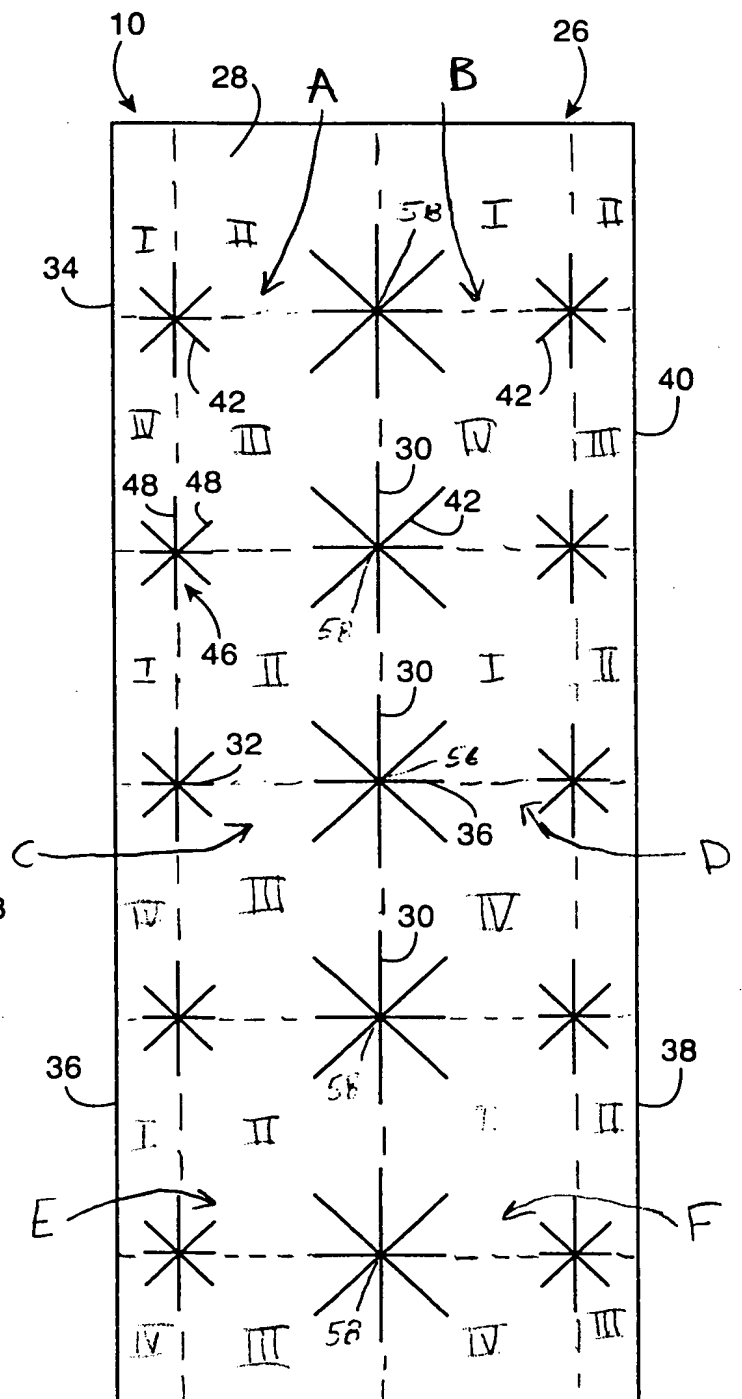


FIG. 8